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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,415	03/27/2001	Alejandro M. Grignetti	AUTEP117	1371
25920 7590 02/24/2011 MARTINE PENILLA & GENCARELLA, LLP 710 LAKEWAY DRIVE SUITE 200 SUNNYVALE, CA 94085				
EXAMINER EL CHANTIL, HUSSEIN A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/818,415

**Applicant(s)**

GRIGNETTI, ALEJANDRO M.

**Examiner**

HUSSEIN A. EL CHANTI

**Art Unit**

2441

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s) Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to petition RCE received Jan. 12, 2011. Claims 1-12 and 14-21 are pending examination.

#### ***Drawings***

2. Formal Drawings are required to be submitted by the applicant.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 16-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-21 lack or not limited to physical articles or objects which are structurally and functionally interconnected to the code in such a manner or to establish a statutory category of invention and enable the code to act as a computer component and realize its functionality. An amendment to the claims to explicitly state that the computer medium is a "non-transitory" medium would overcome the rejection.

#### ***Claim Objections***

4. Claim 19 is objected to because of the following informalities:

Claim 19 depends on claim 19. Examiner assumes that claim 19 depends on claim 16. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens et al., U.S. Patent No. 6,321,231 (referred to hereafter as Jebens) in view of Multer et al., U.S. Patent 6,671,757 (referred to hereafter as Multer).

As to claims 1 and 12, Jebens teaches an apparatus and method comprising:

a non-volatile storage medium capable to store digital content received from a data communication network (see col. 4 lines 42-col. 5 lines 2);

a display communicatively coupled to the non-volatile storage medium, wherein the display is operable to display images of the digital content subsequent to downloading and storing the digital content, and wherein the display is operable to render the digital content using a browser regardless of whether the apparatus is coupled to the data communication network (see co. 5 lines 2-23),

a processor communicatively coupled to the non-volatile storage medium, that is operable to execute the browser (see col. 5 lines 2-23 and col. 12 lines 11-44, the user displays the images using a browser).

Jebens does not explicitly teach that the device is a portable device. However, Multer teaches a system and method for downloading digital content wherein the user device is a portable device (see col. 3). It would have been obvious for one of the ordinary skill in the art at the time of the invention to use a portable device in Jebens as taught by Multer. Motivation to do so comes from the knowledge well known in the art

that using a portable device would allow the user to access the content from any geographic location and therefore making the method and system easier to use.

As to claim 2, Jebens teaches the apparatus of claim 1 wherein the data communications network includes the internet (see col. 7 lines 1-14).

As to claim 3, Jebens teaches the apparatus of claim 1 wherein the digital content includes data relating to any one of a website, an electronic document, a digital photograph, multimedia content, or digital music (see col. 5 lines 2-23).

As to claim 4, Jebens teaches the apparatus of claim 1 wherein the digital content is stored in the non-volatile storage medium as a content bundle (see col. 5 lines 2-23).

As to claim 5, neither Jebens nor Multer teaches that the storage medium is a flash memory. Official notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to implement the use of flash memory in Jebens. Motivation to do so comes from the knowledge well known in the art that flash memory is very widely used and is beneficial due to its relatively small size which would make it easier for the client or user to carry around and therefore would make Jebens apparatus more user friendly.

As to claim 7, Jebens teaches the apparatus of claim 1 wherein the display provides a maximized client window for the browser (see col. 5 lines 23-53).

As to claim 8, Jebens teaches the apparatus of claim 1 wherein the apparatus is communicatively coupled to a host processing device and wherein digital content is

downloaded to the non-volatile storage medium in response to print commands issued in the host processing device (see col. 12 lines 11-65).

As to claim 9, Jebens teaches the apparatus of claim 1 wherein the apparatus is communicatively coupled to a host processing device and wherein the apparatus is capable to perform a first operation in response to a command from a first user and the host processing device is capable to perform a second task in response to a command from a second user (see col. 12 lines 11-65).

As to claim 10, Jebens teaches the apparatus of claim 1 wherein the processor executes the content browsing engine so that the client window of the content browsing engine remains on display during the operation of the apparatus (see col. 12 lines 11-65).

As to claim 11, Jebens teaches the apparatus of claim 1 wherein the content browsing engine is capable to call upon a helper engine to assist in decoding the digital content (see col. 12 lines 11-65).

**6.** Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens in view of Multer and further in view of Leatherman et al., U.S. Patent No. 6,275,746 (referred to hereafter as Leatherman).

Neither Jebens nor Multer teaches that the device includes a touch screen to receive user input. However, Leatherman teaches a device have a browser with a touch screen to receive user input (see col. 4 lines 28-44). It would have been obvious for one of the ordinary skill in the art at the time of the invention to implement the use of touch screen in Jebens. Motivation to do so comes from the knowledge well known in the art

that the use of touch screen input devices are easy to use and do not require additional pieces of hardware and therefore would make Jebens' apparatus more user friendly.

7. Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens et al., U.S. Patent No. 6,321,231 (referred to hereafter as Jebens) in view of Multer and further in view of Kondo et al., U.S. Patent No. 6,170,074 (referred to hereafter as Kondo).

As to claims 14 and 16, Jebens teaches a method and medium for receiving data cast transmission, the method comprising:

receiving a data cast transmission including content bundles (see col. 5 lines 32-55);

filtering the received content bundles so that the selected content bundles are stored in a non-volatile storage (see col. 5 lines 31-41); and

displaying at least some of the stored content bundles, wherein the stored content bundles are displayed using a browser on a peripheral browsing device coupled to non-volatile storage (see col. 5 lines 46-col. 6 lines 17 and col. 12 lines 11-44).

Jebens does not explicitly teach that the device is a portable device. However, Multer teaches a system and method for downloading digital content wherein the user device is a portable device (see col. 3). It would have been obvious for one of the ordinary skill in the art at the time of the invention to use a portable device in Jebens as taught by Multer. Motivation to do so comes from the knowledge well known in the art that using a portable device would allow the user to access the content from any geographic location and therefore making the method and system easier to use.

Neither Jebens nor Multer teaches that the transmission is a HDTV transmission. However, Kondo does (see col. 1 lines 13-40). It would have been obvious for one of the ordinary skill in the art at the time of the invention to incorporate the transmission of HDTV signals in Jebens as taught by Kondo. Motivation to do so comes from the teachings of Kondo that sending HDTV signals would allow portable devices to display a much higher resolution with high color definition and would therefore make the system and method more efficient.

As to claims 15 and 18, Jebens teaches the method of claim 14, further comprising:

transmitting a feedback information to a broadcaster of the content bundles in response to receiving the selected content bundles (see col. 3 lines 32-55).

As to claim 17, neither Jebens nor Multer teaches that the storage medium is a flash memory. Official notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to implement the use of flash memory in Jebens. Motivation to do so comes from the knowledge well known in the art that flash memory is very widely used and is beneficial due to its relatively small size which would make it easier for the client or user to carry around and therefore would make Jebens apparatus more user friendly.

As to claim 19, Jebens teaches the medium of claim 16 wherein the feedback information includes a usage history that a user has viewed (see col. 2 lines 30-46).

As to claim 20, Kondoi teaches the device is coupled to an HDTV receiver capable of accepting HDTV transmission (see col. 1 lines 13-40)



**8.** Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens in view of Multer, in view of Kondo and further in view of Leatherman et al., U.S. Patent No. 6,275,746 (referred to hereafter as Leatherman).

Jebens, Multer and Kondo do not teach that the device includes a touch screen to receive user input. However, Leatherman teaches a device have a browser with a touch screen to receive user input (see col. 4 lines 28-44). It would have been obvious for one of the ordinary skill in the art at the time of the invention to implement the use of touch screen in Jebens. Motivation to do so comes from the knowledge well known in the art that the use of touch screen input devices are easy to use and do not require additional pieces of hardware and therefore would make Jebens' apparatus more user friendly.

**9.** Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUSSEIN A. EL CHANTl whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571)272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hussein Elchanti/  
Primary Patent Examiner

Feb. 23, 2011